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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

ATTORNEY DOCKET NO. **AUS000192US1**

In re Application of:	§	
DUTTA, ET AL.	§	Examiner: **JAVID AMINI**
Serial No.: **09/583,346**	§	Art Unit: **2672**
Filed: **May 31, 2000**	§	
For: **SYSTEM AND METHOD FOR DISPLAYING DATA ON A PORTABLE DEVICE**	§	

APPEAL BRIEF

Commissioner for Patents
Mail Stop Appeal Briefs – Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This present Brief is submitted in triplicate in support of the Appeal in the above-identified application.

CERTIFICATE OF MAILING
37 CFR 1.8(A)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner of Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Annis Zohlen — 10/14/03 Date

REAL PARTY IN INTEREST

The real party in interest in the present application is the Assignee, International Business Machines Corporation of Armonk, New York, as evidenced by the Assignment set forth at Reel 010839/Frame 0548.

RELATED APPEALS AND INTERFERENCES

There are no Appeals or Interferences known to Appellant, the Appellant's legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 2-8, 11, 12, 14-17, 20, 21, 23-26 and 28-30 stand finally rejected by the Examiner as noted in the Examiner's Action dated April 10, 2003.

STATUS OF AMENDMENTS

No amendment has been submitted subsequent to the final rejection.

SUMMARY OF THE INVENTION

As described in the present specification at page 3, lines 13 et seq., the method, system of the present invention described a technique for permitting the display on a portable device to "flip" itself between different screen orientations such that both the narrow dimension and wide dimension of the display can be exploited. A preferred embodiment which particularly adapted to displaying Web data on wireless devices, such as portable telephones, permits the Web data to be effectively display by flipping the display orientation between the narrow and wide dimensions of the display either as selected by user action or dynamically by the portable device itself.

As illustrated within Figures 2A and 2B, and as described in the present specification at page 6, lines 3 et seq., two different orientations of display of the same portable telephone device **205** are depicted. Display **210** is depicted as extending across most of the face of telephone **205**, with a microphone **215** located at one end of the display and a speaker **220** at the opposite end of the display.

As illustrated in Figure 2A, data **225** is shown oriented so that the text is read across the narrow dimension of display **210**, as is conventional with most current portable telephones. It should be clear that reading the data in this display can be quite difficult. However, as depicted in Figure 2B, data **230** has been rotated 90° so that it extends across the wide dimension of display **210**, rendering that data much easier to read.

As set forth in the present specification at page 6, lines 22 et seq., the data being displayed at any given time within display **210** will determine whether it would be preferably displayed across the narrow dimension as is data **225** or across the wide dimension as is data **230**. Applicant describes a preferred embodiment as one in which the user can either chose a display mode at any time and can easily "flip" between the wide and narrow views. As set forth at column 6, lines 28 et seq., "The actual software or firmware programming needed to display the data in these two modes is considered well within the abilities of persons of ordinary skill in the art."

As illustrated within Figure 3 and as described in the present specification at page 7, line 15 et seq., the process by which the programmed device can elect to display data in either a wide or narrow orientation is illustrated. As depicted at step **315**, the device may display data in a default orientation or, alternatively, "the device can automatically determine the best-fit orientation for the display. By examining the line-width of the text being received, the device will determine whether the wide or narrow orientation will be used as the default orientation for that set of text."

ISSUES

1. Is the Examiner's rejection of claims 28-30 under 35 U.S.C. § 112, *first paragraph*, as based upon a non-enabling disclosure well founded?

2. Is the Examiner's rejection of claims 2-8, 11, 12, 14-17, 20, 21, 23-26 and 28-30 under 35 U.S.C. § 102(b) as anticipated by *Wharton et al.*, United States Patent No. 5,831,664 well founded?

GROUPING OF THE CLAIMS

For purposes of this Appeal claims 2-8, 11, 12, 14-17, 20, 21, 23-26 and 28-30 stand or fall together as a single group.

ARGUMENT

The Examiner has rejected claims 28-30 under 35 U.S.C. § 112, *first paragraph*, as being based upon a disclosure which the Examiner believes in not enabling. That rejection is not well founded and it should be reversed.

According to the Examiner, the "definition and parameters of 'analyzing the data page' and are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." Further, the Examiner believes "Applicant should show how the data page analysis is done in this invention."

Applicant respectfully disagrees with the Examiner's position and notes that the specification of the present application, at page 7, lines 15 et seq., specifically describes the user requesting a "Web page, or other data page using a wireless device. . . "

Thereafter, the "Web page or other data page" is displayed by the device after the device has automatically determined the best-fit orientation for the display. This analysis is described at page 7, lines 8 et seq., wherein the specification describes the process as occurring "by examining the line-width of the text being received, the device will determine whether the wide or narrow orientation will be used as the default orientation for that set of text."

It is well settled in the law that "A patent must contain a description that enables one skilled in the art to make and use the claimed invention. . ." However, "An inventor need not, however, explain ever detail since he is speaking to those skilled in the art." In re *Howarth*, 210 USPQ 689 (CCPA, 1981). Further, Courts have repeatedly held that "not every last detail is to be described, else patent specifications would turn into production specification, which they were never intended to be". In re *Gay*, 135 USPQ 311 (CCPA, 1962). This position has been

repeatedly upheld by the Federal Circuit, see for example *DeGeorge v. Bernier*, 226 USPQ 758 (Fed. Cir. 1985).

Thus, the question of whether the claims in the present application are based upon non-enabling disclosure is one which must be determined by determining whether or not one having ordinary skill in the art would have the skill necessary to program a device to determine the line-width of text or other data being received in order to determine whether a wide or narrow orientation should be utilized as the default orientation for that display. For example, if the Web page to be displayed comprised a column of twelve, four digit numbers which are to be summed, then the line width of each of the first twelve lines in the display would be four bits and the line width of the summation would comprise five or six bits. In such a display it should be obvious that a vertical orientation of that display would be most efficient display of that data.

In contrast, if these remarks were to be displayed on a portable device it can clearly be determined that each line of text comprising sixty or seventy letters and that the horizontal orientation would be best suited for a display of these remarks. It should also be considered that even if the Web page to be displayed comprises a graphic image, such images are generally digitally transmitted and specified as a matrix of pixels such as 800 x 640 pixels. Analysis of such a graphic display is therefore as simple as an analysis of text or numeric data in that the width of each line within the image to be displayed is determined and utilized to automatically display that data in the best-fit orientation for the display of the device in question.

As a consequence of this explanation, it is hoped that the Board will comprehend that the specification of the present application clearly includes a teaching sufficient to allow one having ordinary skill in this art to program a telephone or other device in a manner such as that described within the specification so that the line-width of each line within the Web page is

determined and the orientation of the display thereafter automatically chosen to provide the best-fit for that display. As a consequence, Applicant urges that the Examiner's rejection of claims 28-30 under 35 U.S.C. § 112, *first paragraph*, is not well founded and reversal of that rejection is respectfully requested.

Next, the Examiner has rejected claims 2-8, 11, 12, 14-17, 20, 21, 23-26 and 28-30 under 35 U.S.C. § 102(b) as anticipated by *Wharton et al.*, United States Patent No. 5,831,664. That rejection is not well founded and it should be reversed.

The Examiner has taken the position that the various Figure 3's depicted in *Wharton et al.* depict various orientations and that *Wharton et al.* disclose an interactive terminal which allows a user to change a control graphic display based upon an input signal from the user. The Examiner has failed to note that portion of *Wharton et al.* relied upon by the Examiner to anticipate the steps or means for analyzing a data page and thereafter automatically displaying the data page in either a first orientation or a second orientation in response to the analysis of the data page. Consequently, as this element is clearly absent from the teaching of *Wharton et al.*, this reference cannot form the basis for a proper rejection under 35 U.S.C. § 102 since a rejection of the claimed invention over a single reference must show every element of the claimed invention in order to sustain that rejection. *See*, In re *Bond* 15 USPQ2nd 1566 (Fed. Cir. 1999).

As each rejection under 35 U.S.C. § 102(b) necessarily includes a rejection under 35 U.S.C. § 103, Applicant has carefully examined *Wharton et al.* for any suggestion contained therein for the claimed invention in the present application and urges that *Wharton et al.* is deficient as a reference under this standard as well. The Examiner has taken the position that the depictions within Figure 3F and Figure 4 of *Wharton et al.* depict two different orientations; however, such an assertion is based, at best, upon a severely strained interpretation of the

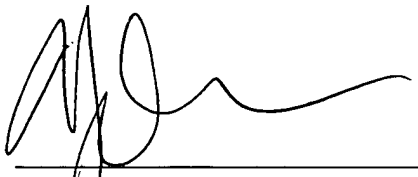
language in the present claims. The present specification and claims are directed to a device having a display which is "significantly larger in a first dimension than in a second dimension" and thereafter, automatically displaying a database in either of first orientation or a second orientation in response to an analysis of that data page. Applicant respectfully urges the Board to consider that the display in *Wharton et al.* is that of an Apple Newton™ Personal Digital Assist (PDA) and that the display in each of the Figures within Newton is always oriented in the same manner. Figures 3F and 4 differ in that additional data is displayed along with the map depicted within Figure 3F; however, the display is "oriented" in the so-called "portrait" orientation in each and every depiction within *Wharton et al.* and consequently, Applicant urges that the Examiner's position that *Wharton et al.* depicts automatically displaying data in either a first orientation or a second orientation is without merit and that position should be reversed.

Further, as noted above, *Wharton et al.* is entirely and completely silent on the subject of automatically analyzing a data page and thereafter displaying that data page in either a first orientation or a second orientation as set forth within the claims of the present application and consequently, Applicant urges that *Wharton et al.* cannot be said to show or suggest in any way the invention set forth within the claims of the present application.

In summary, Applicant urges that the Examiner's position with respect to the enabling nature of the present disclosure and the anticipation, showing or suggestion of the claimed invention by the *Wharton et al.* reference is not well founded and it should be reversed.

Please charge the fee of $330.00 for submission of a Brief in Support of Appeal to IBM Corporation Deposit Account No. 09-0447. No additional filing fee is believed to be necessary; however, in the event that any additional fee is required, please charge it to IBM Deposit Account Number 09-0447.

Respectfully submitted,



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APPENDIX

1. Cancelled

2. The method of claim 28, wherein the data page is received over a wireless connection.

3. The method of claim 28, wherein the second orientation is a ninety-degree rotation of the first orientation.

4. The method of claim 28, wherein the device comprises a display that is significantly larger in a first dimension than in a second direction orthogonal to the first dimension.

5. The method of claim 28, wherein the data page is redisplayed in response to a user input.

6. The method of claim 28, wherein the data page is redisplayed after a preset duration.

7. The method of claim 28, wherein in the portable device is a wireless telephone.

8. The method of claim 28, wherein the portable device is a personal digital assistant.

9. Cancelled

10. Cancelled

11. The portable data processing system of claim 29, wherein the data page is received over a wireless connection.

12. The portable data processing system of claim 29, wherein the second orientation is a ninety-degree rotation of the first orientation.

13. Cancelled

14. The portable data processing system of claim 29, wherein the data page is displayed in response to a user input.

15. The portable data processing system of claim 29, wherein the data page is redisplayed after a preset duration.

16. The data processing system of claim 29, wherein the portable data processing system is a wireless telephone.

17. The data processing system of claim 29, wherein the portable data processing system is a personal digital assistant.

18. Cancelled

19. Cancelled

20. The computer program product of claim 30, wherein the data page is received over a wireless connection.

21. The computer program product of claim 30, wherein the second orientation is a ninety-degree rotation of the first orientation.

22. Cancelled

23. The computer program product of claim 30, wherein the data page is redisplayed in response to a user input.

24. The computer program product of claim 30, wherein the data page is redisplayed after a preset duration.

25. The computer program product of claim 30, wherein the portable device is a wireless telephone.

26. The computer program product of claim 30, wherein the portable device is a personal digital assistant.

27. Cancelled

28. A method for displaying data on a portable device having a display that is significantly larger in a first dimension than in a second dimension, said method comprising the steps of:

receiving a data page in the portable device;

analyzing the data page; and

automatically displaying the data page in either a first orientation or a second orientation within the display in response to the analysis of the data page.

29. The portable data processing system having a processor, writeable memory and a display which is significantly larger in a first dimension than in a second dimension, said portable data processing systems comprising:

means for receiving a data page in the portable data processing system;

means for analyzing the data page; and

means for automatically displaying the data page in either a first orientation or a second orientation within the display in response to the analysis of the data page.

30. A computer program product for use within a portable data processing device having a display that is significantly larger in a first dimension than in a second dimension, said computer program product comprising:

media readable by the portable data processing device;

instructions embodied within the media for receiving a data page within the portable data processing device;

instructions embodied within the media for analyzing the data page; and

instructions embodied within the media for automatically displaying the data page in either a first orientation or a second orientation within the display in response to the analysis of the data page.